

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 22 of 27

REMARKS

Claims 1, 3-4, 49-123, 127-131, and 133-134 were pending in the subject application. Claims 1, 3-4, 70, 79-80, 82, 84-85, 92-94, 96, 101, 110-111, 113, 115 and 120 are withdrawn from consideration by the Examiner as drawn to non-elected subject matter. By this Amendment, Claims 1 and 3-4 have been canceled without prejudice or disclaimer, Claim 56 has been amended, and new Claim 137 has been added. Support for the amendments to Claim 56 can be found in at least Claim 57 and Claim 116. Support for Claim 137 can be found at least in Claim 87 and previous Claim 124. Applicant maintains that the amendments do not raise an issue of new matter. Accordingly, entry of the amendment is respectfully requested.

Election of Species Requirements

Applicant requests that upon determination of the allowability of a generic claim, the Examiner examine currently withdrawn claims directed to non-elected species (37 CFR §1.141, MPEP §806.04(d)).

Rejections under 35 U.S.C. §102/103

1. Claims 49 and 88 are rejected under 35 U.S.C. §102(a) as being anticipated by Yeh et al. (J. Biol. Chem., Papers in Press, 14 Jan 2002) (herein after "the JBC Article").
2. Claims 50-61, 63-69, 72, 74, 81, 86 and 89-90 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yeh et al. (J. Biol. Chem., 29 Jan 2002) ("the JBC Article") in view of Haugland et al. (U.S. Patent No. 5,635,608).
3. Claims 49-54, 56-58, 60, 61, 63-69, 72, 74, 78, 81, 83, 86, 89-91, 95, 97-100, 103, 105, 109, 112, 114, 116-119, 123, 127-131 and 133-134 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chen et al. (J. Am. Chem. Soc., 12 Apr 2002, published on internet 22 Mar 2002) (herein after "the JACS Article") in view of Haugland

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 23 of 27

et al. (U.S. Patent No. 5,635,608).

Applicant respectfully traverses these rejections.

As set forth in the attached Declaration of David S. Lawrence under 35 U.S.C. §1.132, both the JBC Article and the JACS Article are authored by applicant and his coworkers.

The JBC Article is authored by Ren-Hwa Yeh, Xiongwei Yan, Michael Cammer, Anne R. Bresnick and the applicant. As set forth in the attached Declaration, Ren-Hwa Yeh, who at that time was a postdoctoral fellow in applicant's laboratory, was included as an author on the JBC Article because he assisted in performing the cell-based studies of the sensors as per applicant's direction. Xiongwei Yan, who at that time was a postdoctoral fellow in applicant's laboratory, was included as an author on the JBC Article because he assisted in synthesizing and screening the library of potential protein kinase sensors as per applicant's direction. Michael Cammer, who at that time was Director of Light Microscopy and Image Analysis in the Analytical Imaging Facility at the Albert Einstein College of Medicine, was included as an author on the JBC Article because he assisted in training Ren-Hwa Yeh in microinjection techniques and helped analyze data as per applicant's direction. Anne R. Bresnick, who is a faculty member in applicant's department, was included as an author on the JBC Article because she provided advise on cell-based studies. None of Ren-Hwa Yeh, Xiongwei Yan, Michael Cammer or Anne R. Bresnick contributed to the conception of the invention claimed in the present application.

The JACS Article is authored by Chien-An Chen, Ren-Hwa Yeh and the applicant. As set forth in the attached Declaration, Chien-An Chen, who at that time was a postdoctoral fellow in applicant's laboratory, was included as an author on the JACS Article because he synthesized the sensors as per applicant's direction. Ren-Hwa Yeh, who at that time was a postdoctoral fellow in applicant's laboratory, was included as an author on the JACS Article because he assisted in performing the enzyme-based studies as

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 24 of 27

per applicant's direction. Neither Chien-An Chen nor Ren-Hwa Yeh contributed to the conception of the invention claimed in the present application.

The JBC Article and the JACS Article were published online on January 14, 2002 and March 22, 2002, respectively, which are both less than one year before the January 10, 2003 filing date of priority document U.S. Provisional Patent Application No. 60/439,359. Therefore, the JBC Article and the JACS Article are not prior art (e.g., MPEP §2141.01). Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

4. Claims 49-69, 71-77, 81, 83, 86-90, 95, 97-100, 102-109, 112, 114, 116-119, 122-123, 127-131, 133 and 134 are rejected under 35 U.S.C. §102(e) as being anticipated by Nguyen et al., U.S. Patent Application Publication No. US2004/0166553 ("Nguyen"). Nguyen claims priority of 7 U.S. Provisional Patent Applications, the earliest of which has a priority date of November 18, 2002.

Applicant respectfully traverses this rejection.

As set forth in the attached Declaration of David S. Lawrence under 35 U.S.C. §1.131, the inventor declares that he had reduced aspects of the claimed invention to practice in the United States before the November 18, 2002 priority date of Nguyen et al., U.S. Patent Application Publication No. US2004/0166553, as evidenced by the January 14, 2002 JBC Article and the March 22, 2002 JACS Article. The experiments described in these publications were carried out in the applicant's laboratory in the Department of Biochemistry at Albert Einstein College of Medicine, Bronx, New York. Attached to the Declaration is a copy of the Data Supplement for the JBC Article and the Supporting Information (10 pages) for the JACS Article, which were available online at the time of publication. The JBC Data Supplement Table (124 pages) corresponds to Table 3 of the present application. The JBC Article provides support for subject matter recited in at least

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 25 of 27

the following claims that are rejected as anticipated by Nguyen: Claims 49-51, 61, 63-65, 67-69, 72-74, 81, 88, 90, 98-100, 103-105, 112, and 117-119. The JACS Article provides support for subject matter recited in at least the following claims that are rejected as anticipated by Nguyen: Claims 49, 61, 63-69, 72-74, 81, 83, 89 (see in particular attached Supporting Information), 90, 95, 97-100, 103-105, 112, 114, 116-119, 127-131, and 133-134. Accordingly, on the basis of the JBC Article and the JACS Article, applicant maintains that Nguyen is not prior art under 35 U.S.C. §102(e) for at least the subject matter recited in Claims 49-51, 61, 63-69, 72-74, 81, 83, 88-90, 95, 97-100, 103-105, 112, 114, 116-119, 127-131, and 133-134.

The Examiner's rejection based on Nguyen mentions the compound shown in Figure 59B of Nguyen and discussed in paragraph [0545] on page 52 of Nguyen. This compound is claimed in the present application in Claims 55, 59 and 122. A portion of the compound is claimed in Claims 53 and 57. The subject matter of Claims 53, 55, 57, 59 and 122 appears in the same claims in priority application, U.S. Provisional Application No. 60/505,097, filed September 23, 2003. Figure 59 was included in the Nguyen application filed on November 17, 2003, but does not appear in the 7 US Provisional Patent Applications from which Nguyen claims priority. Since the November 17, 2003 filing date of Nguyen is after the September 23, 2003 filing date of priority application U.S. Provisional Application No. 60/505,097, applicant maintains that Nguyen is also not prior art under 35 U.S.C. §102(e) for the subject matter recited in Claims 53, 55, 57, 59 and 122.

Independent Claim 56 has herein above been amended to incorporate features of Claim 57 and Claim 116. Accordingly, applicant maintains that Claim 56 is not anticipated by Nguyen. In addition, applicant maintains that dependent Claims 52, 54, 58, 60, 62, 71, 75-77, 86-87, 102, 106-109, 123 and 137, which depend from and

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 26 of 27

incorporate the limitations of independent Claims 49, 56, 89, 90 or 103, are also not anticipated by Nguyen.

Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

Supplemental Information Disclosure Statement

This Supplemental Information Disclosure Statement is being filed to supplement the Information Disclosure Statements filed on January 9, 2004, May 24, 2005 and July 26, 2005 in connection with the subject application. In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicant would like to direct the Examiner's attention to the references listed on attached Form PTO/SB/08A-B (2 pages). Copies of the three non-patent references are also attached hereto.

Applicant: David S. Lawrence
Serial No.: 10/755,086
Filed: January 9, 2004
page 27 of 27

CONCLUSIONS


In view of the amendments and remarks made hereinabove, reconsideration and withdrawal of the rejections set forth in the December 15, 2006 Office Action and passage of the pending claims to allowance are respectfully requested. If there are any minor matters preventing the allowance of the subject application, the Examiner is requested to telephone the undersigned attorney.

A check for \$ 300.00 is enclosed for (i) the \$120.00 fee for a one month extension of time and (ii) the \$180.00 fee for submitting an Information Disclosure Statement. No additional fee is deemed necessary in connection with the filing of this response. However, if any other fee is required to preserve the pendency of the subject application, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 01-1785. Any overpayments may also be credited to Deposit Account No. 01-1785.

Respectfully submitted,

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By 
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